

IN THE DRAWINGS

Please replace the figures with the attached formal drawings.

REMARKS

Claims 1 to 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,152,034 to Dufour (“Dufour ‘034”) in view of U.S. Patent No. 5,813,337 to Peters et al. (“Peters et al. ‘337”). It is respectfully submitted, however, that Dufour ‘034 is not prior art under the provisions of U.S.C. § 103(c).

According to § 103(c):

[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Dufour ‘034 issued on November 28, 2000, after the filing date of the present application (i.e. November 21, 2000), and therefore is not prior art by virtue of 35 U.S.C. § 102 (a) or (b).

Rather, because Dufour ‘034 issued from an application filed on July 26, 1999, it is asserted as prior art by virtue of 35 U.S.C. § 102(e)(2), which in relevant part, recites that “the invention was described in a patent granted on an application by another filed in the United States before the invention by the applicant for patent.”

Both the subject matter of Dufour ‘034 and the claimed invention were, at the time the present invention was made, owned by Heidelberger Druckmaschinen AG. In both the application files of the Dufour ‘034 patent and the present application, assignments have been executed and recorded in the Patent and Trademark Office in accordance with 37 C.F.R. Part 3 and each of those recorded assignments convey the entire rights in the applications to the same organization, i.e. Heidelberger Druckmaschinen AG. (See, MPEP 706.02(I)(2), Establishing Common Ownership, II. A., which states, in relevant part, that the “necessary showing will be considered by the examiner to be present if the application files refer to assignments which are recorded in

the Patent and Trademark Office in accordance with 37 C.F.R. Part 3 as long as the assignments conveyed the entire rights in the applications to the same person or organization.”).

The ‘034 patent assignment was recorded at Reel 010210/ Frame 0057, and the assignment in the present application at Reel 011814/0622.

Because both Dufour ‘034 and the present invention were commonly owned at the time the present invention was made, Dufour ‘034 does not qualify as prior art under 35 U.S.C. § 103(c).

In view of the fact that Dufour ‘034 is not prior art to the present application, withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

CONCLUSION

It is respectfully requested that the rejections of claims 1 to 30 be withdrawn and that the application is now in condition for allowance.

Respectfully submitted,

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